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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL AUSTIN, DON ROBINSON,
DENNIS R. BOULAIS, PRAVEEN KULKARNI,
TOBY FREYMAN, SAMUEL J. EPSTEIN,
WENDY NAIMARK, and MARLENE SCHWARZ

Appeal 2011-000958
Application 10/797,704
Technology Center 1700

Before BRADLEY R. GARRIS, LINDA M. GAUDETTE, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 the final rejection of claims 17, 19-29, and 36-39. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We REVERSE.

Appellants' invention is said to be directed to a system for manufacturing a coated medical device involving the use of rollers (Spec. para. [0001]). Appellants' Figure 9a illustrates an embodiment where coating is transferred from first roller 91 to second roller 92 and ultimately applied to medical device 90 (Spec. para. [0068]).

Claim 22 is illustrative:

22. A system for coating a stent having a tubular portion with an outer surface, wherein the system comprises:

a coating material source containing a coating material comprising a solvent and a biologically active material;

a first roller having a surface;

a doctor blade in proximity to the first roller surface positioned to remove excess coating material from the first roller surface; and

a second roller having a surface, wherein:

the first roller is situated relative to the coating material source so that the coating material in the coating material source is transferred to the first roller surface;

the first roller and second roller are situated relative to each other so that the first roller transfers the coating material transferred to the first roller surface to the second roller surface, and

the second roller is situated relative to the tubular portion so that the second roller transfers the coating material

transferred to the second roller surface to the outer surface of the tubular portion.

Appellants appeal the following rejections:

1. Claims 21-26 and 36-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pacetti '544 (US 2005/0074544 A1 published Apr. 7, 2005) in view of Shibata¹ (JP 11-111423 A published Apr. 23, 1999).
2. Claims 17 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pacetti '544 in view of Shibata, and Pacetti '874 (US 7,175,874 B1 issued Feb. 13, 2007).
3. Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Pacetti '544 in view of Shibata, Pacetti '874 and Layrolle (US 2001/0008649 A1 published July 19, 2001).
4. Claims 27-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pacetti '544 in view of Shibata and Kirk-Othmer

¹ The Examiner cites Shibata US Patent 6,111,345 as an English language equivalent of the Japanese publication 11-111423 (Ans. 3). The Examiner states that the United States Patent & Trademark Office's Scientific and Technical Information Center (STIC) provided the Shibata US patent as an English language equivalent (*id.* at 2). Appellants argue that the Shibata Japanese application 11-111423 was filed February 12, 1998, which is after the filing date of the application that matured into the Shibata US patent (App. Br. 7). Appellants further contend that JP 11-111423 is not listed a priority document on the US patent. *Id.* The Examiner does not dispute Appellants' arguments and instead concedes that the rejection will focus solely on the teachings and suggestions provided in the English language abstract and figures of JP 11-111423 (Ans. 10). No formal translation of JP 11-111423 is of record. Thus, we shall not consider the disclosure contained in US Patent 6,111,345 to Shibata in rendering our decision.

(KIRK-OTHMER, ENCYCLOPEDIA OF CHEMICAL TECHNOLOGY 607-24 (3d ed. 1982)).

5. Claim 39 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Pacetti '544 in view of Shibata and Pomper (US 2,842,092 issued July 8, 1958).

ISSUES

Did the Examiner establish that it would have been obvious to substitute Shibata's indirect coating structure for Pacetti '544's direct coating structure without resorting to impermissible hindsight? We decide this issue in the negative.

FINDINGS OF FACT AND ANALYSES

The Examiner finds that Pacetti '544 teaches the subject matter of claim 22, except for the claimed indirect/transfer coating structure of a first and second roll (Ans. 4). The Examiner finds that Shibata teaches in the English-language abstract and Figure 5 that it was known to provide for an indirect roller coating arrangement to enable a more metered coating of a cylindrically shaped object (*id.*). The Examiner finds that Shibata's indirect coating apparatus has a structure that corresponds to the claimed structure (*id.* at 4-5). The Examiner concludes that it would have been obvious to one of ordinary skill in the art to substitute Shibata's indirect coating arrangement for Pacetti '544's direct coating arrangement "as an alternative arrangement for coating the stent to allow for a more metered supply of coating material onto the surface of the stent thereby enhancing uniformity in coating on the surface of the stent" (*id.* at 5).

Appellants argue that the Examiner's citation to the English language abstract and Figure 5 of Shibata do not support the conclusion that the indirect coating structure provides a more metered coating or enhances uniformity of the coating (App. Br. 11). Appellants contend that the Examiner has not cited a prior art teaching that supports the broad general assertion comparing the direct and indirect coating structures. *Id.* Appellants contend that the Examiner engaged in impermissible hindsight and speculative reasoning to arrive at the claimed invention. *Id.*

The Examiner responds that it is "conventional wisdom" that Shibata's indirect coating system provides a more uniform and better metered coating because excess lumps, air bubbles, etc. are removed via the transference of coating material from roller to roller (Ans. 11).

Appellants reply that Shibata's English-language abstract does not support the Examiner's reasoning that an indirect coating system provides better metering with enhanced uniformity in the coating (Reply Br. 6-7).

Having fully considered Appellants' arguments and the Examiner's findings, we determine that the preponderance of the evidence favors Appellants' conclusion of nonobviousness. While the Examiner provides reasoning that the indirect coating system is "conventional wisdom" to one of ordinary skill in the art, the only evidence the Examiner cites to support such a proposition includes the English-language abstract and Figure 5 of the Japanese document. Shibata's English-language abstract and Figure 5 do not state or depict anything about the indirect coating structure providing better metering. The Examiner has not pointed to any evidence other than Shibata's English-language abstract and Figure 5 to support the finding that

it is “conventional wisdom” that indirect coating structure provides better metering and enhanced uniformity (Ans. 4, 11).

The Examiner’s reason for substituting Shibata’s indirect coating structure for Pacetti ‘544’s direct coating structure is based on speculative and unsupported reasoning and findings. Appellants challenge the Examiner’s findings and reasoning, but the Examiner has not provided evidentiary support to substantiate the speculative findings regarding the reason for combining the references and what would have been known to one of ordinary skill in the art. Absent a credible reason for the Examiner’s proposed modification of Pacetti ‘544 with Shibata, we determine that the Examiner engaged in impermissible hindsight to piece together the teachings of the references and arrive at the claimed invention. Accordingly, the Examiner has failed to establish a prima facie case of obviousness.

We reverse all of the Examiner’s § 103 rejections.

DECISION

The Examiner’s decision is reversed.

ORDER

REVERSED

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